



D-1116R1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of)	
J. Richard Hanna, et al.)	
)	
Serial No.: 09/408,858)	Art Unit 2876
)	
Confirm. No.: 4536)	
)	Patent Examiner
Filed: September 30, 1999)	Jared J. Fureman
)	
Title: Automated Merchant Banking)	
Apparatus and Method)	

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

**SUPPLEMENTAL BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby respectfully request reinstatement of the appeal pursuant to 37 C.F.R. § 1.193(b)(2). The Appellants hereby submit their Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192, in triplicate, concerning the above-referenced Application.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this matter.

STATUS OF CLAIMS

Claims 1-30 are pending in the Application.

Claims 22-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Johnston.

Claims 22-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sharman et al. ("Sharman").

Claims 1, 3, 5-6, 8, 11, 21-24, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Peters et al. ("Peters") in view of Johnston.

Claims 2, 4, 12, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Cataldo et al ("Cataldo").

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Graef et al ("Graef").

Claims 9-10, 13, 15, 17, 20, and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Henry et al ("Henry").

Claims 16 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Cataldo and Henry.

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Blumstein et al ("Blumstein").

Claims 18-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Abccassis.

Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Tranchita et al ("Tranchita").

These rejections were the only rejections present in the Office Action ("Action") dated December 23, 2002. Appellants appeal the rejections of the claims, inclusive.

STATUS OF AMENDMENTS

The following dates and papers are associated with this application:

1. 01/30/02 First (Non-final) Office Action Rejection
2. 04/11/02 Applicants' Response
3. 06/26/02 Second (Final) Office Action Rejection
4. 08/05/02 Notice of Appeal
5. 10/03/02 Appeal Brief
6. 12/23/02 Third (Non-final) Office Action Rejection

Appellants desire to proceed with their appeal to prevent further unnecessary prosecution delay by the Office. Furthermore, as shown in more detail herein, Appellants' claims are allowable over the new grounds of rejection applied in the Action. Thus, Appellants respectfully request reinstatement of their appeal pursuant to 37 C.F.R. § 1.193(b)(2).

No final rejection has been made. However, claims have been thrice rejected. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

SUMMARY OF INVENTION

Overview of the Invention

An exemplary form of the invention is directed to an apparatus and a method of providing a depositor (user) with assurance that a deposit accepting machine, such as an ATM, has recorded the fact that they made the deposit. The machine can include an item accepting depository (54) for accepting items for deposit, such as currency. A depositor may input data associated with the deposit item, such as an amount or a depository bag ID number, to be received by the machine. An image of the deposited item inside the machine can be captured with an interior imaging device, such as a camera (326). An image of the depositor can also be captured with an exterior imaging device, such as a camera (58). The inputted data, deposited item image, and depositor image can be stored in a memory storage device, such as in a single combined image. The inputted data, deposited item image, and depositor image can also be simultaneously displayed through a machine display. That is, the user image captured from camera (58) and the deposited item image captured from camera (326) can be displayed (along with other data) to the user through a display screen (424) of the machine (Figure 50; Specification page 61, lines 5-22).

Figures 26 and 28 show an exemplary form of the deposit accepting machine operative to accept deposits. An exterior camera (58) can capture an image of the user. A door (56) is movable to an open position to enable a user to access an interior area of the machine through an open access opening (57). A rotating pocket assembly (318) can serve as an item transport for a deposit item. The assembly (318) includes a first pocket (320) and a second pocket (322). After a user inserts an item to be deposited into the adjacent pocket, the assembly (318) can be rotated

(Specification page 39, lines 19-23). This rotation causes the deposit item to be transported away from the access opening so that it can no longer be accessed again by the user. That is, the deposit item becomes a deposited item. The deposited item can be passed by gravity out of the pocket and into a throat area (324). The throat area (324) includes a camera (326) therein. The camera (326) can serve as an interior imaging device which has a field of view including the interior area of the machine (Specification page 40, lines 5-7). The camera (326) can capture an image of the deposited item. The camera (326) may be an infrared camera which is capable of delivering images of deposited items in near total darkness conditions which may exist in the internal area of the machine in the vicinity of the throat area. The deposited item can continue into a secure chest (62). Further description related to an exemplary form of the invention may be found, for example, at Specification page 57, line 16 to page 63, line 8.

CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are:

- 1). Whether Appellants' claims 22-23 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Johnston.
- 2). Whether Appellants' claims 22-23 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Sharman.
- 3). Whether Appellants' claims 1, 3, 5-6, 8, 11, 21-24, and 27 are unpatentable under 35 U.S.C. § 103(a) over Peters in view of Johnston.
- 4). Whether Appellants' claims 2, 4, 12, and 25 are unpatentable under 35 U.S.C. § 103(a) over Peters in view of Johnston and Cataldo.

- 5). Whether Appellants' claim 7 is unpatentable under 35 U.S.C. § 103(a) over Peters in view of Johnston and Graef.
- 6). Whether Appellants' claims 9-10, 13, 15, 17, 20, and 29-30 are unpatentable under 35 U.S.C. § 103(a) over Peters in view of Johnston and Henry.
- 7). Whether Appellants' claims 16 and 26 are unpatentable under 35 U.S.C. § 103(a) over Peters in view of Johnston and Cataldo and Henry.
- 8). Whether Appellants' claim 14 is unpatentable under 35 U.S.C. § 103(a) over Peters in view of Johnston and Blumstein.
- 9). Whether Appellants' claims 18-19 are unpatentable under 35 U.S.C. § 103(a) over Peters in view of Johnston and Abecassis.
- 10). Whether Appellants' claim 28 is unpatentable under 35 U.S.C. § 103(a) over Peters in view of Johnston and Tranchita.

GROUPING OF CLAIMS

No groups of claims stand or fall together. Every claim recites additional features of the invention which distinguishes the claim over every other pending claim.

Each of Appellants' claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

The pending claims include three independent claims (claims 1, 22, and 29). Claims 2-21 depend from claim 1. Claims 23-28 depend from claim 22. Claim 30 depends from claim 29.

All pending claims 1-30 are reproduced in the Appendix.

ARGUMENT

Appellants' previous remarks in their Appeal Brief dated October 3, 2002 are herein incorporated by reference.

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are

known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The Peters Reference

Phillips is directed to an ATM capable of loading a receipt or a mini statement to a flex disc (34). Other information may also be loaded to the flex disc, such as an image of a scanned document (e.g., check) and an image of the user. The flex disc can be used on a home computer in association with a spreadsheet of the users bank account.

The Johnston Reference

Johnston is directed to a depository apparatus for envelopes and documents. The apparatus includes an envelope transport section (35) and a document transport section (36). The document transport section (36) includes scanning means (76). An image of a deposit document is displayed on a screen (24) prior to its deposit. After displaying the document, the document can then be returned to the user. Otherwise, with user confirmation to deposit the displayed document, the document can later be "eventually deposited" in a bin module (86) (col. 6, line 64 to col. 7, line 10; col. 5, lines 33-60).

The Cataldo Reference

Cataldo is directed to a bank deposit identification device. A dual lens camera can be operated to photograph the depositor and deposit package. The dual camera may be a movie camera to record the operation from the opening of the chute door to the closing thereof.

The Graef Reference

Graef is directed to an article depositing apparatus. A transport belt (370) conveys a document deposit over an image scanner (80). An image of the downward facing side of the document deposit is obtained and conveyed to a CPU of the ATM (col. 20, lines 13-21).

The Henry Reference

Henry is directed to a programmable electronic lock. A display screen (28) is used by the electronic lock (12) to communicate with a user (col. 5, lines 52-53). The lock is configured with a keypad (22) to allow a user to input data into the lock (col. 5, lines 36-37). Security may be increased through a dual validation process of key and PIN code entry (col. 3, lines 6-8).

The Blumstein Reference

Blumstein is directed to a customer activated terminal for visually impaired. Blumstein teaches a method of entering numerical information. For each digit of a multidigit number a first touch screen location is touched a number of times equal to the digit followed by touching a second location. Once all the digits have been entered, a third location is touched.

The Abecassis Reference

Abecassis is directed to a deposit authorization system. A deposit is tendered for the purchase of goods. The system permits a purchase deposit slip to exclude card information, provide for a delivery date, and utilize a transaction number. The transaction number both identifies the deposit transaction and represents an approval number.

The Tranchita Reference

Tranchita is directed to auxiliary illumination of a surveillance area. The external surveillance field of view for a camera may be illuminated using an infrared laser.

(iii) 35 U.S.C. § 102

(Issue 1) The Pending Claims Are Not Anticipated By Johnston

In the Action claims 22-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Johnston. The Appellants respectfully disagree with the Action's interpretation of Johnston.

The Action alleges that Johnston teaches a deposit accepting machine (10), a display (24), and an item imaging device (scanning means 76).

Johnston does not teach each and every step, feature, and relationship of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections. Johnston does not anticipate the recited method claims. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejections should be withdrawn.

Claim 22

Johnston does not teach depositing an item inside a deposit accepting machine, and displaying an image of the deposited item through a display operatively connected to the deposit accepting machine. Johnston does not teach that a depositor is provided assurance of the deposit.

As previously discussed in the "Summary of Invention" section, Appellants' disclosure provides basis for displaying an image of a deposited item to provide the depositor (machine user) assurance that the deposit accepting machine has recorded the fact that they made the

deposit (e.g., Specification page 6, lines 15-17; page 62, lines 2-3). Appellants' disclosure provides further basis that a deposited item cannot be accessed by the depositor (e.g., Specification page 39, 19-22).

Johnston teaches (e.g., col. 6, line 64 to col. 7, line 10; col. 5, lines 33-60) that the deposit item can be returned to the user after displaying an image of the deposit item. Johnston also admits that the displayed document can later be "eventually deposited" (col. 7, line 3). In Johnston an image of the item is first displayed, then the user needs to confirm (col. 5, lines 52 and 55; col. 6, line 67) whether the item should be deposited. If the user does not confirm, then the item is returned to the user. The Appellants respectfully submit that if Johnston's displayed item can be returned then it was never "deposited." That is, Johnston does not teach displaying an image of a deposited item. Contrarily, Johnston specifically teaches displaying an image of a document prior to that document being deposited. In Johnston's operational sequence the item can only be deposited following the displaying of the item. That is, in Johnston's chain of events any depositing only occurs after the displaying. Johnston, at best, only displays an image (e.g., a pre-deposit image) of an item which may or may not be later "eventually deposited."

Johnston does not display an image of a deposited item. It follows that Johnston does not teach that "a depositor is provided assurance of the deposit." It further follows that Johnston cannot anticipate claim 22.

Response to the Action's additional remarks regarding Johnston

The Action provides additional remarks regarding Johnston beginning at page 17, paragraph number 16. The Action states that claim 22 "merely" recites "depositing an item inside a deposit accepting machine." The Appellants respectfully disagree. The Office

misinterprets claim 22. Claim 22 clearly recites "displaying an image of the deposited item." As previously discussed, Johnston does not display an image of a deposited item. At best, Johnston only displays a pre-deposit image of an item.

The Action (on page 18) further indicates that there is nothing in claim 22 "that requires that an item can no longer be accessed or retrieved again by the user, to be defined as a deposit item." The Appellants again respectfully disagree. Claim 22 recites that a depositor is provided assurance of the deposit. As previously discussed, Appellants' disclosure provides basis for this "assurance." How can assurance that an item was indeed deposited be provided if the item can be retrieved, which is the situation in Johnston? Assurance is provided by depositing the item inside a deposit accepting machine and displaying an image of the deposited item. Johnston provides no assurance that an item was deposited.

Appellants further respectfully submit that one having ordinary skill in the art of making a deposit to a deposit accepting machine (e.g., ATM) can distinguish the difference between a "deposited item" and an item not deposited. That is, a "deposited" (past tense) item has well known ordinary meaning in the art. A claim term takes its ordinary meaning unless the Applicant redefined the term in the record using words of "manifest exclusion or restriction." *Texas Digital Systems Inc. v. Telegenix Inc.*, 308 F.3d 1193, 64 USPQ2d 1812 (Fed. Cir. 2002). The Office incorrectly attempts to substitute the well known term "deposited" with the term "placed." However, with the Office's reasoning one could have deposited many cash items into an ATM without ever affecting their bank account. Johnston does not anticipate claim 22.

Claim 23

Johnston does not teach "capturing an item image of the deposited item inside the deposit accepting machine with an imaging device." Where does Johnston teach capturing an image of a deposited item? Contrarily, Johnston specifically teaches capturing an image of a document prior to the document being deposited. It follows that Johnston cannot anticipate claim 23.

(Issue 2)

The Pending Claims Are Not Anticipated By Sharman

In the Action claims 22-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sharman. The Appellants respectfully disagree with the Action's interpretation of Sharman.

Claim 22

Sharman does not teach depositing an item inside a deposit accepting machine, and displaying an image of the deposited item through a display operatively connected to the deposit accepting machine. Sharman does not teach that a depositor is provided assurance of the deposit.

Sharman does not teach the recited method for reasons similar to those previously discussed with regard to Johnston. Those reasons are herein incorporated by reference. In Sharman, like in Johnston, a document can be returned to the depositor (page 8/2). That is, the document can be returned after the relied upon step number 6 (page 8/5). At best, Sharman only displays a pre-deposit image of an item. Sharman, like Johnston, provides no assurance that an item was deposited.

Furthermore, where does Sharman specifically teach displaying an image of the deposited item through a display "operatively connected to the deposit accepting machine"? Sharman merely indicates that an "image of the document is displayed to the consumer" (page 8/5, step

number 6). The Office has not proved that displaying an item image through a display "operatively connected to the deposit accepting machine" is "necessarily present" in Sharman. Nor are the Action's allegations based on any evidence in the record. *In re Zurko*, supra. For example, what prevents the document image in Sharman from being displayed to the consumer by providing a printed paper image to the consumer? Sharman does not anticipate claim 22.

Claim 23

Sharman also does not teach "capturing an item image of the deposited item inside the deposit accepting machine with an imaging device." It follows that Sharman cannot anticipate claim 23.

(iv) 35 U.S.C. § 103

Appellants traverse the rejections on the grounds that Appellants' claims recite steps, features, and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The steps, features, and relationships recited in Appellants' claims patentably distinguish over the applied references. Nor would it have been obvious to one having ordinary skill in the art to have combined the teachings of the references to have produced the recited invention.

The Office does not factually support any *prima facie* conclusion of obviousness. If the Office does not produce a *prima facie* case, which is the current situation, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). Thus, it is

respectfully submitted that the 35 U.S.C. § 103(a) rejections are improper and should be withdrawn.

(Issue 3)

**The Pending Claims Are Not Obvious Over
Peters in view of Johnston**

Claims 1, 3, 5-6, 8, 11, 21-24, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston. These rejections are respectfully traversed.

Claim 1

Peters does not teach or suggest the recited steps, features, and relationships. The Action (at page 5, lines 1-6) admits that Peters does not teach "capturing an item image of a deposit item placed inside the deposit accepting machine with an interior area imaging device, wherein the interior area imaging device has a field of view including an interior area inside the deposit accepting machine" or "displaying the user image and the item image to the user through a display operatively connected to the deposit accepting machine." That is, the Action admits that Peters does not teach either step (b) or step (c). (Detailed reasons, with which the Office apparently agreed via the reopening of prosecution, as to why Peters does not teach step (b) or step (c) may be found in the Appeal Brief dated October 3, 2002 which was incorporated herein by reference).

The Action only relies on Johnston as teaching step (b). Johnston does not teach or suggest step (c). That is, Johnston does not teach or suggest displaying a user image (or capturing a user image in step (a)). Nor does the Action rely on Johnston as teaching or

suggesting step (c). The Action provides no teaching or suggestion of step (c). That is, the Action admits that Peters does not teach step (c) yet provides no teaching or suggestion thereof.

The Action has not presented any factual evidence that it was known in the prior art to display a user image and an item image to a user through a display operatively connected to a deposit accepting machine. The record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Office bears the burden of establishing that all the recited features of the claim are known in the prior art. Appellants respectfully submit that the Office has not met this burden. Contrarily, the Action admits that not all of the recited features have been shown. The Office does not factually support any *prima facie* conclusion of obviousness.

Appellants respectfully submit that all of the remaining 35 U.S.C. § 103(a) rejections are likewise deficient, because they are also based on the deficient alleged combination of Peters and Johnston.

Continuing, there is no evidence that Peters' ATM display screen (14) is even capable of "displaying" a user image and an item image to a user. There is no evidence that Peters has the hardware and software arrangements necessary to permit the ATM display screen (14) to display a user image and an item image to a user. Contrarily, Peters teaches that the image data is written to a disc (34). Peters only teaches that the disc's image data is displayed on a modified home PC (50), not through a display in the manner recited. Additionally, Peters desires to reduce space within the ATM (col. 1, lines 11-12; col. 2, lines 23-25). Thus, Peters teaches away from having the additional hardware and software features necessary to permit the ATM display screen

(14) to display a user image and an item image to a user. Therefore, even if it were somehow possible to provide a separate teaching of step (c), it would not have been obvious to have modified Peters' ATM to display both a user image and an item image to a user. The alleged combination would appear to destroy the desired utility and operability of the Peters teaching. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Returning to step (b), as previously discussed, the Action admits that Peters does not teach step (b). Appellants disagree with the Action's allegation that Johnston teaches step (b). Johnston teaches two scanning means (76) located on opposite sides of a document feed path (col. 4, lines 41-43). The arrangement permits both sides of an item to be scanned (col. 6, lines 3-6). Each scanning means includes a respective line scan camera which scans along a fixed line transverse to the direction of item movement (col. 5, lines 1-18). Appellants question how Johnston's oppositely placed scanners (76) could have a "field of view" of "an interior area inside" of the machine. Thus, even if it were somehow possible to modify Peters with the teaching of Johnston, the features of step (b) would not have been met.

Additionally, the Action (page 5, lines 11-12) admits that Peters fails to teach that the image of a deposit item is captured when the deposit item is in an internal area, i.e., when the deposit item is inside the machine. Thus, even if Johnston's scanning means somehow had a "field of view" of "an interior area inside" the machine, it would not have been obvious to have modified Peters with such teaching. That is, it would not have been obvious to have modified

Peters with the ability of "capturing an item image of a deposit item placed inside the deposit accepting machine."

Neither Peters nor Johnston, taken alone or in combination, disclose or suggest the recited steps. Nor would it have been obvious to have combined the references to have produced the recited invention. Additionally, even if it were somehow possible to combine the references (which it isn't) the resultant combination would not have been obvious because the prior art does not suggest the desirability of the combination (MPEP § 2143.01). Furthermore, the resultant combination would not have resulted in the recited invention.

The attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure. It follows that it would not have been obvious to have modified the references in the manner alleged. The Action lacks a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, supra. *In re Newell*, supra. Without a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01).

In conclusion, the Office has not established a *prima facie* showing of obviousness.

Claim 3

Claim 1 has been previously shown to be allowable. It is asserted that claim 3, which depends from claim 1, is allowable on at least the same basis. Claim 3 also recites a storing step that further patentably distinguishes the claimed invention.

Claim 5

The Action (page 5, lines 9-12) admits that Peters fails to teach "moving the deposit item away from the access opening with the item transport to a first internal area wherein the deposit is not accessible through the access opening, wherein the image of the deposit item in step (b) is captured when the deposit item is in the first internal area." That is, the Action admits that Peters fails to teach moving a deposit item to an inaccessible area prior to capturing an image of the deposit item.

Johnston cannot alleviate the admitted deficiencies of Peters. Nor does the Action explain how Peters could be modified with the teachings of Johnston to produce the recited invention. Since the Action does not explain the rejections with reasonable specificity it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

Furthermore, the alleged combination would appear to destroy the disclosed and desired utility and operability of the Peters teaching. *In re Fine*, supra. Neither Peters nor Johnston, taken alone or in combination, disclose or suggest the recited steps. The Office has not established a *prima facie* showing of obviousness.

Claim 6

Claim 6 depends from claim 5. The Action (page 5, lines 12-16) admits that Peters fails to teach that "the interior area of the deposit accepting machine includes a second internal area, wherein the deposit item is stored in the interior area in the second internal area, and subsequent to step (c) further comprising the step of passing the deposit item from the first internal area to the second internal area."

Johnston cannot alleviate the deficiencies in Peters for the reasons previously discussed. Nor has the Action explained how Peters (which the Action admits lacks the recited features) could be modified to include the teachings of Johnston. Neither Peters nor Johnston, taken alone or in combination, disclose or suggest the recited steps. The Office has not established a *prima facie* showing of obviousness.

Claim 8

Neither Peters nor Johnston, taken alone or in combination, disclose or suggest "enabling the user to access the interior area to place the deposit item therein." Where does Peters teach or suggest permitting a user to access an interior area inside the ATM, especially to place a deposit item therein? Where does Johnston teach or suggest permitting a user to access an interior area inside the ATM, especially to place a deposit item therein?

Additionally, the claim language "the interior area" (line 7) has antecedent basis in claim 1. Thus, even if it were somehow possible to include Johnston's scanning means (76) inside of Peters' ATM, there is no teaching or suggestion that a user would be able to access the scanner's "field of view" of "an interior area inside" (claim 1) the ATM. Thus, the Office has not established a *prima facie* showing of obviousness.

Claim 11

Claim 11 depends from claim 8. Claim 8 has been previously shown to be allowable. It is asserted that claim 11 is allowable on at least the same basis. Claim 11 further patentably distinguishes the claimed invention. Neither Peters nor Johnston, taken alone or in combination, disclose or suggest an input device and input received in the manner recited.

Claim 21

Neither Peters nor Johnston, taken alone or in combination, disclose or suggest an apparatus including the deposit accepting machine, external area imaging device, internal area imaging device, and display recited in claim 1. Nor do Peters nor Johnston, taken alone or in combination, disclose or suggest that the apparatus can be operated responsive to a computer to perform the method steps recited in claim 1. It follows that the Office has not established a *prima facie* showing of obviousness.

Claim 22

Claim 22 recites some subject matter similar to subject matter in claim 1. Appellants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. Thus, it is respectfully submitted that claim 22 also patentably distinguishes over Peters in view of Johnston.

Peters does not teach or suggest depositing an item inside a deposit accepting machine, and displaying an image of the deposited item through a display operatively connected to the deposit accepting machine. It follows that Peters does not teach or suggest that a depositor is provided assurance of the deposit. Furthermore, the Action admits (page 5, lines 5-6) that Peters does not teach "displaying the user image and the item image to the user through a display

operatively connected to the deposit accepting machine." Thus, the Action apparently admits that Peters does not teach "displaying an image of the deposited item through a display operatively connected to the deposit accepting machine."

Nevertheless, Peters does not provide deposit assurance. Peters does not explicitly or inherently teach or suggest using a display (operatively connected to a deposit accepting machine) for displaying an image of a deposit item.

As previously discussed, Appellants' disclosure provides basis for displaying an image of the deposited item to provide the user assurance that the deposit accepting device has recorded the fact that they made the deposit (e.g., Specification page 6, lines 15-17; page 62, lines 2-3).

Furthermore, even if it were somehow possible (which it isn't) for Peters to display an image of a deposit item on the display screen (14), there is still no teaching that the image would be that of a deposited item. Claim 22 recites displaying an image of a deposited item.

As previously discussed in the "Summary of Invention" section, Appellants' disclosure provides basis for displaying an image of a deposited item to provide the depositor assurance that the deposit accepting machine has recorded the fact that they made the deposit (e.g., Specification page 6, lines 15-17; page 62, lines 2-3). Appellants' disclosure provides further basis that a deposited item cannot be accessed by the depositor (e.g., Specification page 39, 19-22). Where does Peters specifically teach or suggest scanning of a "deposited" document? What teaching in Peters prevents a user from retrieving the scanned document? It follows that Peters does not teach or suggest that "a depositor is provided assurance of the deposit."

Johnston cannot alleviate the deficiencies in Peters in regard to the recited features of claim 22. As previously discussed, Johnston does not teach or suggest the recited features of

claim 22. Appellants' previous remarks regarding Johnston in Issue 1 are herein incorporated by reference.

Johnston teaches (e.g., col. 6, line 64 to col. 7, line 10; col. 5, lines 33-60) that the deposit item can be returned to the user after displaying an image of the deposit item. Johnston also admits that the displayed document can later be "eventually deposited" (col. 7, line 3). Johnston does not display an image of a deposited item. It follows that Johnston does not teach or suggest that "a depositor is provided assurance of the deposit." Thus, it would not have been obvious to have combined the references to have produced the recited invention.

It follows that neither Peters nor Johnston, taken alone or in combination, disclose or suggest the recited features of claim 22. It further follows that the Office has not established a *prima facie* showing of obviousness.

Claim 23

Peters does not teach or suggest "capturing an item image of the deposited item inside the deposit accepting machine with an imaging device." Peters does not explicitly or inherently teach or suggest capturing an image of an item inside a deposit accepting machine nor capturing an image of a deposited item. It follows that Peters cannot teach or suggest displaying an image of a deposited item through a display operatively connected to the deposit accepting machine.

Johnston cannot alleviate the deficiencies in Peters in regard to the recited features of claim 23. As previously discussed, Johnston does not teach or suggest the recited features of claim 23. Appellants' previous remarks regarding Johnston in Issue 1 are herein incorporated by reference. Neither Peters nor Johnston, taken alone or in combination, disclose or suggest the recited features of claim 23. Nor has a showing of *prima facie* obviousness been established.

Claim 24

Claim 24 depends from claim 23. As previously discussed, the Action (page 5, lines 5-6) admits that Peters does not teach "displaying the user image and the item image to the user through a display operatively connected to the deposit accepting machine." It follows that Peters does not teach or suggest displaying both an image of a deposited item and a depositor image through a display. Thus, Peters does not teach or suggest the recited features of claim 24.

As previously discussed (e.g., Issue 1), Johnston does not teach or suggest displaying an image of a deposited item. As previously discussed (e.g., remarks regarding claim 1), Johnston does not teach or suggest displaying an image of a depositor. It follows that Johnston does not teach or suggest displaying both an image of a deposited item and a depositor image through a display.

Neither Peters nor Johnston, taken alone or in combination, disclose or suggest displaying a depositor image through a display operatively connected to the deposit accepting machine. Neither Peters nor Johnston, taken alone or in combination, disclose or suggest displaying an image of a deposited item through the display. Thus, neither Peters nor Johnston, taken alone or in combination, disclose or suggest the recited features of claim 24.

Claim 27

Claim 27 depends from claim 24. The Action (at page 5, lines 4-5) admits that Peters does not teach an "imaging device" having "a field of view including an interior area inside the deposit accepting machine." As previously discussed, Appellants question how Johnston's oppositely placed scanners (76) could have a "field of view" of "an interior area inside" of the machine. Thus, even if it were somehow possible to include Johnston's scanning means (76)

inside of Peters' ATM, there is no teaching or suggestion that a user would be able to access the scanner's "field of view" of "an interior area inside" the ATM. Thus, the Office has not established a *prima facie* showing of obviousness.

(Issue 4)

**The Pending Claims Are Not Obvious Over
Peters in view of Johnston and Cataldo**

Claims 2, 4, 12, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Cataldo. These rejections are respectfully traversed.

Appellants' remarks involving Peters in view of Johnston in support of the patentability of claims 1 and 22-24 are incorporated by reference as if fully rewritten herein.

Claim 2

Neither Peters/Johnston nor Cataldo teach or suggest simultaneously displaying a user image and an item image to a user through a display operatively connected to a deposit accepting machine.

As previously discussed, neither Peters nor Johnston, taken alone or in combination, disclose or suggest displaying both an image of a deposited item and a depositor image through a display. It follows that neither Peters nor Johnston, taken alone or in combination, disclose or suggest simultaneously displaying an image of a deposited item and a depositor image. Even the Action (page 7, last paragraph) admits that "Peters et al as modified by Johnston fails to specifically teach that the user image and the item image are simultaneously displayed through the display."

Cataldo cannot alleviate the deficiencies in Peters/Johnston in regard to the recited features. Cataldo teaches use of film. However, there is no teaching or suggestion that Cataldo's film is capable of being displayed through a display. Nor is there any teaching or suggestion that Cataldo's depository even has a display. Even the Action (page 8, line 12) acknowledges that Cataldo lacks a display. Nor is there any teaching or suggestion that Cataldo's film is capable of being displayed through a display operatively connected to Cataldo's depository (11). Nor is there any teaching or suggestion that Cataldo simultaneously displays a user image and an item image to a user of the depository. Cataldo's film appears to be only for the bank's usage. It follows that Cataldo does not teach or suggest simultaneously displaying a user image and an item image to a user through a display operatively connected to a deposit accepting machine.

Nor is there any teaching or suggestion that the display of Peters/Johnston ("Peters") is capable of displaying Cataldo's film therethrough. Peters is associated with a "digital" image not with film. Furthermore, there isn't any teaching or suggestion that Peters' display is even capable of displaying images. Peters does not teach or suggest using a display (operatively connected to a deposit accepting machine) for displaying a captured user image and a captured item image to a user. There is no teaching or suggestion that Peters' display screen (14) is capable of displaying a user image and an item image to a user, especially simultaneously displayed images. Thus, it would not have been obvious to have combined the references to have produced the recited invention.

It would not have been obvious to one having ordinary skill in the art to have even considered displaying Cataldo's film through Peters' display. Any attempt to modify Peters/Johnston with the teaching of Cataldo would destroy the disclosed and desired utility and

operability of the Peters/Johnston teaching. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Neither Peters/Johnston nor Cataldo, taken alone or in combination, disclose or suggest the recited steps. Nor would it have been obvious to have combined the references to have produced the recited invention. Additionally, even if it were somehow possible to combine the references (which it isn't) the resultant combination would not have been obvious because the prior art does not suggest the desirability of the combination (MPEP § 2143.01).

The Action has not presented any factual evidence that it was known in the prior art to simultaneously display a user image and an item image to a user through a display operatively connected to a deposit accepting machine. Thus, the Office has not presented a *prima facie* showing of obviousness.

Claim 4

The Action (page 8, first paragraph) admits that Peters/Johnston fails to teach that a "user image is captured responsive to the user moving a door to a position opening an access opening."

Cataldo cannot alleviate the admitted deficiencies in Peters/Johnston in regard to the recited features. Nor does the Action explain how Peters/Johnston could be modified with the teachings of Cataldo to produce the recited invention. Since the Action does not explain the rejections with reasonable specificity it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). Neither

Peters/Johnston nor Cataldo, taken alone or in combination, disclose or suggest the recited steps. The Office has not established a *prima facie* showing of obviousness.

Claim 12

Claim 12 depends from claim 2. The Action (page 7, last line to page 8, first line) admits that Peters/Johnston fails to teach that a user image and an item image are displayed as a single combined image, and further comprising the step of storing the single combined image in a storage device.

Cataldo cannot alleviate the deficiencies in Peters/Johnston in regard to the recited features. As previously discussed, Cataldo does not display a user image and an item image to a user through a display operatively connected to a deposit accepting machine. It follows that neither Peters/Johnston nor Cataldo, taken alone or in combination, disclose or suggest displaying a user image and an item image as a single combined image. The Office has not established a *prima facie* showing of obviousness.

Claim 25

Claim 25 depends from claim 24. The Action (page 7, last paragraph) admits that Peters/Johnston "fails to specifically teach that the user image and the item image are simultaneously displayed through the display."

Cataldo cannot alleviate the deficiencies in Peters/Johnston in regard to the recited features. Note Appellants' remarks regarding claim 2.

Neither Peters/Johnston nor Cataldo, taken alone or in combination, disclose or suggest simultaneously displaying a depositor image and an item image through a display in the manner recited. The Office has not established a *prima facie* showing of obviousness.

(Issue 5)

**The Pending Claims Are Not Obvious Over
Peters in view of Johnston and Graef**

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Graef. These rejections are respectfully traversed.

Appellants' remarks involving Peters in view of Johnston in support of the patentability of claims 1 and 3 are incorporated by reference as if fully rewritten herein.

Claim 7

Claim 7 depends from claim 3. Neither Peters/Johnston nor Graef, taken alone or in combination, teach or suggest displaying both a user image and an item image (e.g., claim 1), nor storing the user image and the item image in associated relation in a storage device (e.g., claim 3), nor accessing at least one of the item image and the user image from a remote computer through the server (e.g., claim 7).

The Action (page 9, lines 14-16) admits that Peters/Johnston fails to teach that a "storage device is in operative connection with a server, and further comprising the step of accessing the item image from a remote computer through the server." Where does Graef teach or suggest accessing an image (which was also displayed) from a remote computer through a server? Graef does not teach or suggest displaying an image (i.e., check image) to a user. Thus, it would not have been obvious to have combined the references to have produced the recited invention.

(Issue 6)

**The Pending Claims Are Not Obvious Over
Peters in view of Johnston and Henry**

Claims 9-10, 13, 15, 17, 20, and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Henry. These rejections are respectfully traversed.

Appellants' remarks involving Peters in view of Johnston in support of the patentability of claims 1 and 22 are incorporated by reference as if fully rewritten herein. Henry does not teach or suggest displaying a user image or an item image. Henry is non analogous art.

Claim 9

Claim 9 depends from claim 8. The Action (page 11, lines 5-6) admits that Peters/Johnston fails to teach that a "user input received includes a deposit bag identifier." As previously discussed (e.g., claim 8), Peters/Johnston does not teach or suggest permitting a user to access an interior area inside the machine, especially to place a deposit item therein. That is, Peters/Johnston is not capable of receiving a deposit item such as a deposit bag. Thus, it would not have been obvious to one having ordinary skill in the art to have attempted to modify Peters/Johnston to permit receiving a user input of a deposit bag identifier. It follows that the Office has not established a *prima facie* showing of obviousness.

Claim 10

Claim 10 depends from claim 8. The Action (page 11, lines 6-7) admits that Peters/Johnston fails to teach that an "input received includes a deposit bag identification number input through the keypad." Henry cannot alleviate the deficiencies in Peters/Johnston in regard to the recited features. Note Appellants' remarks regarding claim 9.

Claim 13

Claim 13 depends from claim 8. The Action (page 11, lines 7-9) admits that Peters/Johnston fails to teach that "user input further including amount data representative of an amount associated with the deposit item, and wherein the amount is displayed through the display with the user image and the item image."

As previously discussed (e.g., claim 1), Peters/Johnston does not teach or suggest displaying both a user image and an item image. Henry also does not teach or suggest displaying a user image or an item image. Henry is non analogous art. It follows that neither Peters/Johnston nor Henry, taken alone or in combination, can teach or suggest displaying amount data (representative of an amount associated with a deposit item) through a display with a user image and an item image. Nor has the Office established a *prima facie* showing of obviousness.

Claim 15

Claim 15 depends from claim 13. The Action (page 11, lines 9-11) admits that Peters/Johnston fails to teach "storing data representative of the amount with the user image and item image in associated relation in a storage device." Neither Peters/Johnston nor Henry store amount, user image, and item image in the manner recited. As previously discussed (e.g., claim 13), neither Peters/Johnston nor Henry, taken alone or in combination, teach or suggest displaying amount data through a display with a user image and an item image. It follows that neither Peters/Johnston nor Henry, taken alone or in combination, teach or suggest storing data representative of the amount, user image, and item image in associated relation in a storage

device. Thus, it would not have been obvious to have combined the references to have produced the recited invention.

Claim 17

Claim 17 depends from claim 15. As previously discussed (e.g., claim 15), neither Peters/Johnston nor Henry, taken alone or in combination, teach or suggest storing data representative of an amount, user image, and item image in associated relation in a storage device. It follows that neither Peters/Johnston nor Henry, taken alone or in combination, teach or suggest storing data representative of recorded time, an amount, user image, and item image in associated relation in a storage device. Furthermore, as previously discussed, Henry is non analogous art. The Office has not established a *prima facie* showing of obviousness.

Claim 20

Claim 20 depends from claim 17. The Action (page 11, lines 11-12) admits that Peters/Johnston fails to teach "accessing with a remote computer through the server the associated stored data representative of the recorded time and amount." As previously discussed (e.g., claim 17), neither Peters/Johnston nor Henry, taken alone or in combination, teach or suggest storing data representative of recorded time, an amount, user image, and item image in associated relation in a storage device. It follows that neither Peters/Johnston nor Henry, taken alone or in combination, teach or suggest accessing with a remote computer through a server the associated stored data representative of the recorded time, amount, user image, and item image. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 29

Appellants' remarks in support of the patentability of claims 1, 13, and 22 are incorporated by reference as if fully rewritten herein. Neither Peters/Johnston nor Henry, taken

alone or in combination, teach or suggest displaying depositor input data (associated with a deposit item), a depositor image, and an image of a deposited item through a display operatively connected to a deposit accepting machine.

As previously discussed (e.g., claim 1), Peters/Johnston does not teach or suggest displaying both a user image and a deposit item image. As previously discussed (e.g., claim 22), Peters/Johnston does not teach or suggest displaying an image of a deposited item. The Action (page 11, lines 5-9) admits that Peters/Johnston fails to teach that depositor input data (and user image and item image) is displayed through a display. It follows that Peters/Johnston does not teach or suggest "displaying the data, a depositor image, and an image of the deposited item through a display operatively connected to the deposit accepting machine."

Henry cannot alleviate the deficiencies in Peters/Johnston in regard to the recited features. Henry is non analogous art. Henry does not teach or suggest displaying a user image or an item image. It follows that Henry does not teach or suggest displaying both a user image and an item image. Nor does Henry teach or suggest displaying an image of a deposited item. It further follows that Henry cannot teach or suggest "displaying the data, a depositor image, and an image of the deposited item through a display operatively connected to the deposit accepting machine."

It follows that neither Peters/Johnston nor Henry, taken alone or in combination, teach or suggest displaying depositor input data (associated with a deposit item), a depositor image, and an image of a deposited item through a display operatively connected to a deposit accepting machine. Nor has the Office established a *prima facie* showing of obviousness.

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Office bears the burden of establishing that all the recited features of the claim are known in

the prior art. The Appellants respectfully submit that the Office has not met this burden. The record lacks substantial evidence support. *In re Zurko*, supra.

The attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. The Action lacks a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, supra. *In re Newell*, supra. Without a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01). It would not have been obvious to have combined the references to have produced the recited invention. In conclusion, the Office has not established a *prima facie* showing of obviousness.

Claim 30

Claim 30 depends from claim 29. The Action (page 7, last paragraph) admits that Peters/Johnston "fails to specifically teach that the user image and the item image are simultaneously displayed through the display." It follows that Peters/Johnston cannot teach or suggest simultaneously displaying depositor input data, a depositor image, and an item image through a display.

Henry cannot alleviate the deficiencies in Peters/Johnston in regard to the recited features. Henry does not teach or suggest displaying a user image or an item image. Henry is non analogous art. It follows that Henry cannot teach or suggest simultaneously displaying depositor input data, a depositor image, and an item image through a display.

Neither Peters/Johnston nor Henry, taken alone or in combination, teach or suggest simultaneously displaying depositor input data, a depositor image, and an item image through a display operatively connected to a deposit accepting machine. The Office has not established a *prima facie* showing of obviousness.

(Issue 7)

**The Pending Claims Are Not Obvious Over
Peters in view of Johnston and Cataldo and Henry**

Claims 16 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Cataldo and Henry. The rejections are respectfully traversed.

Claim 16

Claim 16 depends from claim 15. Appellants' remarks in support of the patentability of claims 1, 8, 13, 15 are incorporated by reference as if fully rewritten herein. The Action (page 14, lines 16-18) admits that Peters/Johnston/Henry fails to teach that an amount, user image, and item image are stored as a single combined image in a storage device.

The Action relies on Cataldo for the recited features. However, Cataldo cannot alleviate the admitted deficiencies in Peters/Johnston/Henry. Cataldo does not teach or suggest storing data representative of an amount associated with a deposit item in a storage device. It follows that Cataldo does not teach or suggest storing an amount associated with a deposit item, a user image, and an item image as a single combined image in a storage device.

Neither Peters/Johnston/Henry nor Cataldo, taken alone or in combination, teach or suggest storing an amount associated with a deposit item, a user image, and an item image as a single combined image in a storage device. Nor would it have been obvious to have combined

the references to have produced the recited invention. The Office has not established a *prima facie* showing of obviousness.

Claim 26

Claim 26 depends from claim 25. Appellants' remarks in support of the patentability of claims 22-25 are incorporated by reference as if fully rewritten herein. The Action (page 13, lines 2-4) admits that Peters/Johnston/Cataldo "fails to specifically teach simultaneously displaying the data along with the depositor image and the item image through the display.

Henry cannot alleviate the admitted deficiencies in Peters/Johnston/Cataldo. Henry does not teach or suggest displaying a user image or an item image. Henry is non analogous art. It follows that Henry cannot teach or suggest simultaneously displaying input data, a depositor image, and an item image through a display. Neither Peters/Johnston/Cataldo nor Henry, taken alone or in combination, teach or suggest simultaneously displaying input data, a depositor image, and an item image through a display.

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Office bears the burden of establishing that all the recited features of the claim are known in the prior art. The Appellants respectfully submit that the Office has not met this burden. The record lacks substantial evidence support. *In re Zurko*, supra. The Office does not factually support any *prima facie* conclusion of obviousness.

(Issue 8)

**The Pending Claims Are Not Obvious Over
Peters in view of Johnston and Blumstein**

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Blumstein. The rejection is respectfully traversed.

Appellants' remarks involving Peters/Johnston in support of the patentability of claims 1 and 8 are incorporated by reference as if fully rewritten herein.

Claim 14

Claim 14 depends from claim 8. The Action (page 13, last paragraph) admits that Peters/Johnston fails to teach that a user input includes data representative of a first amount of a first type item included in a deposit item and a second amount of a second type item included in the deposit item, and wherein the first amount and the second amount are displayed with a user image and an item image. The Action (page 11, line 9) also admits that Peters/Johnston fails to teach amount data displayed through a display with a user image and an item image.

The Action relies on Blumstein for the recited features. However, Blumstein cannot alleviate the admitted deficiencies in Peters/Johnston. Blumstein is non analogous art. Blumstein does not teach or suggest displaying a user image or an item image. It follows that Blumstein does not teach or suggest displaying both a user image and an item image. It further follows that Blumstein cannot teach or suggest that a first amount and a second amount are displayed with a user image and an item image.

Neither Peters/Johnston nor Blumstein, taken alone or in combination, teach or suggest displaying a first amount and a second amount with a user image and an item image to a user through a display operatively connected to a deposit accepting machine. It would not have been

obvious to have combined the references to have produced the recited invention. The Office has not established a *prima facie* showing of obviousness.

(Issue 9)

**The Pending Claims Are Not Obvious Over
Peters in view of Johnston and Abecassis**

Claims 18-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Abecassis. These rejections are respectfully traversed.

Appellants' remarks involving Peters/Johnston in support of the patentability of claims 1 and 8 are incorporated by reference as if fully rewritten herein.

Claim 18

Claim 18 depends from claim 8. The Action (page 15, lines 9-13) admits that Peters/Johnston fails to teach presenting on a display a prompt message for a user to input a receipt number corresponding to a number of receipts to be provided; receiving from a user a receipt number input through an input device operatively connected to the deposit accepting machine; and providing with a receipt delivery device operatively connected to the deposit accepting machine a number of receipts corresponding to the receipt number input by the user. The Action (page 16, lines 14-15) further admits that Peters/Johnston fails to teach inputting a receipt number corresponding to a number of receipts to be provided.

Abecassis cannot alleviate the admitted deficiencies in Peters/Johnston. In Abecassis a single transaction slip can have two sections, an (upper) merchant section and a (lower) customer section (col. 9, lines 29-66). Where does Abecassis permit the number of receipts to be selected? Where does Abecassis permit a user to select the number of receipts to be provided?

Abecassis does not teach or suggest presenting on a display a prompt message for a user (customer) to input a receipt number corresponding to a number of receipts to be provided. Nor does Abecassis teach or suggest receiving from a user a receipt number input through an input device operatively connected to a deposit accepting machine. Nor does Abecassis teach or suggest providing with a receipt delivery device operatively connected to a deposit accepting machine, a number of receipts corresponding to the receipt number input by the user.

Furthermore, Abecassis is non analogous art. Where does Abecassis teach or suggest a deposit accepting machine (e.g., claim 1)? Where does Abecassis teach or suggest displaying a user image or an item image (e.g., claim 1)? Where does Abecassis teach or suggest enabling a user to access a machine interior area to place a deposit item therein (e.g., claim 8)?

Neither Peters/Johnston nor Abecassis, taken alone or in combination, teach or suggest presenting on a display a prompt message for a user to input a receipt number corresponding to a number of receipts to be provided; receiving from a user a receipt number input through an input device operatively connected to a deposit accepting machine; and providing with a receipt delivery device operatively connected to the deposit accepting machine a number of receipts corresponding to the receipt number input by the user.

It would not have been obvious to one having ordinary skill in the art to have modified Peters/Johnston with the teaching of Abecassis to have produced the claimed invention. The Office has not established a *prima facie* case of obviousness.

Claim 19

Claim 19 depends from claim 18. The Action (page 15, lines 13-15) admits that Peters/Johnston fails to teach that a "receipt delivery device includes a printer, wherein in the

printer is operative to print the number of receipts, each receipt includes indicia corresponding to the amount." The Action (page 16, lines 14-16) further admits that Peters/Johnston fails to teach "inputting a receipt number corresponding to a number of receipts to be provided, and the printer printing the number of receipts."

As previously discussed (e.g., claim 18), neither Peters/Johnston nor Abecassis, taken alone or in combination, teach or suggest presenting on a display a prompt message for a user to input a receipt number corresponding to a number of receipts to be provided; receiving from a user a receipt number input through an input device operatively connected to a deposit accepting machine; and providing with a receipt delivery device operatively connected to the deposit accepting machine, a number of receipts corresponding to the receipt number input by the user.

It follows that neither Peters/Johnston nor Abecassis, taken alone or in combination, teach or suggest providing with a printer (operatively connected to a deposit accepting machine) a number of receipts corresponding to the receipt number input by the user. Nor has the Office established a *prima facie* showing of obviousness.

(Issue 10)

**The Pending Claims Are Not Obvious Over
Peters in view of Johnston and Tranchita**

Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Johnston and Tranchita. The rejection is respectfully traversed.

Appellants' remarks involving Peters/Johnston in support of the patentability of claims 22 and 23 are incorporated by reference as if fully rewritten herein.

Claim 28

Claim 28 depends from claim 23. The Action (page 17, lines 8-9) admits that Peters/Johnston fails to teach that an "item image capturing device comprises an infrared camera." As previously discussed, Peters/Johnston also does not teach or suggest capturing an image of a deposited item inside a deposit accepting machine (e.g., claim 23). Nor does Peters/Johnston teach or suggest displaying an image of the deposited item through a display operatively connected to the deposit accepting machine (e.g., claim 22), as previously discussed.

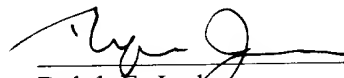
Tranchita cannot alleviate the admitted deficiencies in Peters/Johnston. Tranchita is directed to external surveillance. The external field of view may be illuminated using an infrared laser. Tranchita does not teach or suggest capturing an image of a deposited item inside a deposit accepting machine (e.g., claim 23). Nor does Tranchita teach or suggest displaying an image of the deposited item through a display operatively connected to the deposit accepting machine (e.g., claim 22). It follows that Tranchita does not teach or suggest capturing an image of a deposited item inside a deposit accepting machine with an imaging device comprising an infrared camera.

Thus, neither Peters/Johnston nor Tranchita, taken alone or in combination, teach or suggest capturing an image of a deposited item inside a deposit accepting machine with an imaging device comprising an infrared camera. It would not have been obvious to one having ordinary skill in the art to have modified Peters/Johnston with the teaching of Tranchita to have produced the claimed invention. Nor has the Office established *prima facie* obviousness.

CONCLUSION

Each of Appellants' pending claims specifically recites steps, features, and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000

Reg. No. 31,029



APPENDIX

CLAIMS

1. A method comprising the steps of:
 - (a) capturing a user image of a user with an external area imaging device, wherein the external area imaging device has a field of view including an exterior area outside of a deposit accepting machine;
 - (b) capturing an item image of a deposit item placed inside the deposit accepting machine with an interior area imaging device, wherein the interior area imaging device has a field of view including an interior area inside the deposit accepting machine;
 - (c) displaying the user image and the item image to the user through a display operatively connected to the deposit accepting machine.
2. The method according to claim 1 wherein in step (c) the user image and the item image are simultaneously displayed through the display.

3. The method according to claim 1 and further comprising the step of:

storing the user image and the item image in associated relation in a storage device.

4. The method according to claim 1 wherein the deposit accepting machine includes an access opening, wherein a movable door selectively enables access to the interior area through the access opening, and wherein in step (a) the user image is captured responsive to the user moving the door to a position opening the access opening.

5. The method according to claim 1 wherein the deposit accepting machine includes an access opening to the interior area, wherein the deposit item is passed to the interior area through the access opening, and wherein the deposit accepting machine includes an item transport extending in the interior area, and prior to step (b) further comprising the step of:

moving the deposit item away from the access opening with the item transport to a first internal area wherein the deposit is not accessible through the access opening, and wherein the image of the deposit item in step (b) is captured when the deposit item is in the first internal area.

6. The method according to claim 5 wherein the interior area of the deposit accepting machine further includes a second internal area, wherein the deposit item is stored in the interior

area in the second internal area, and subsequent to step (c) further comprising the step of passing the deposit item from the first internal area to the second internal area.

7. The method according to claim 3 wherein the storage device is in operative connection with a server, and further comprising the step of accessing at least one of the item image and the user image from a remote computer through the server.

8. The method according to claim 1 and further comprising the steps of:

receiving a user input from the user through at least one input device in operative connection with the deposit accepting machine;

comparing through operation of a computer, data corresponding to at least a portion of the user input to data stored in a data store for a corresponding relationship;

enabling the user to access the interior area to place the deposit item therein responsive to the input data and stored data having a corresponding relationship.

9. The method according to claim 8 wherein the user input received includes a deposit bag identifier.

10. The method according to claim 8 wherein the input device includes a keypad, and wherein the input received includes a deposit bag identification number input through the keypad.

11. The method according to claim 8 wherein the input device includes a card reader and the input received includes data encoded on a card.

12. The method according to claim 2 wherein the user image and item image are displayed as a single combined image, and further comprising the step of storing the single combined image in a storage device.

13. The method according to claim 8 wherein the user input further includes amount data representative of an amount associated with the deposit item, and wherein in step (c) the amount is displayed through the display with the user image and the item image.

14. The method according to claim 8 wherein the user input further includes data representative of a first amount of a first type item included in the deposit item and a second amount of a second type item included in the deposit item, and wherein in step (c) the first amount and the second amount are displayed with the user image and the item image.

15. The method according to claim 13 and further comprising the step of storing data representative of the amount, user image and item image in associated relation in a storage device.

16. The method according to claim 15 wherein in the storing step the amount, user image and item image are stored as a single combined image in the storage device.

17. The method according to claim 15 wherein the computer is in operative connection with a clock device, and further comprising recording at least one current time during execution of at least one of the method steps, and wherein in the storing step data representative of the recorded current time is stored in associated relation with the amount, user image and item image.

18. The method according to claim 8 and further comprising the steps of:

presenting on the display a prompt message for a user to input a receipt number corresponding to a number of receipts to be provided;

receiving from a user a receipt number input through an input device operatively connected to the deposit accepting machine;

providing with a receipt delivery device operatively connected to the deposit accepting machine, a number of receipts corresponding to the receipt number input by the user.

19. The method according to claim 18 wherein the receipt delivery device includes a printer, wherein in the providing step the printer is operative to print the number of receipts, wherein each receipt includes indicia corresponding to the amount.

20. The method according to claim 17 wherein the storage device is in operative connection with a server, and further comprising the steps of accessing with a remote computer through the server the associated stored data representative of the recorded time, amount, user image and item image.

21. An apparatus including the deposit accepting machine, external area imaging device, the internal area imaging device, and the display recited in claim 1, operated responsive to a computer to perform the method steps recited in claim 1.

22. A method comprising:

(a) depositing an item inside a deposit accepting machine;

- (b) displaying an image of the deposited item through a display operatively connected to the deposit accepting machine, wherein a depositor is provided assurance of the deposit.

23. The method according to claim 22 and further comprising capturing an item image of the deposited item inside the deposit accepting machine with an imaging device, and wherein the item image is displayed in (b).

24. The method according to claim 23 and further comprising

capturing a depositor image of a depositor with an imaging device, and

displaying the depositor image through the display.

25. The method according to claim 24 comprising simultaneously displaying the depositor image and the item image through the display.

26. The method according to claim 25 and further comprising

receiving a depositor input through at least one input device in operative connection with the deposit accepting machine, wherein the input includes data associated with the item in (a); and

simultaneously displaying the data, the depositor image, and the item image through the display.

27. The method according to claim 24 wherein the item image capturing device has a field of view including an interior area inside the deposit accepting machine, and wherein the depositor image capturing device has a field of view including an exterior area outside of a deposit accepting machine.

28. The method according to claim 23 wherein the item image capturing device comprises an infrared camera.

29. A method comprising:

- (a) receiving a depositor input through at least one input device in operative connection with a deposit accepting machine, wherein the input includes data associated with a deposit item;
- (b) depositing the deposit item inside the deposit accepting machine;
- (c) displaying the data, a depositor image, and an image of the deposited item through a display operatively connected to the deposit accepting machine.

30. The method according to claim 29 wherein (c) includes simultaneously displaying the data, the depositor image, and the deposited item image through the display.